

Remarks

I. SUMMARY

Claims 33 and 88-126 are currently under examination.¹ (Claims 88-123 depend from claim 33. Independent claim 124 is a system claim that recites means-plus-function elements corresponding to the method steps of claim 33. Finally, claims 125 and 126 depend from claim 124.)

In the present non-final action, the Examiner rejected claims 33 and 88-126. The Examiner rejected claims 33 and 88-91, 95-103, 107-110 and 117-126 under 35 U.S.C. §102(e) as anticipated by U.S. Pat. No. 6,895,430 (“Schneider”)². Claims 92-94, 104-106 and 111-116 were rejected under Section 103(a) of the patent law as unpatentable over Schneider in view of Greene et al. (claims 92-94); and over Schneider in view of Hollenbeck et al. (claims 104-106 and 111-116). Applicant respectfully traverses the rejections and requests reconsideration for the reasons set forth below.

In the present response, the first paragraph is amended to clarify that this application claims priority from two provisional applications; but this application is not intended to be a continuation of either of them under 35 U.S.C. §120. Other minor corrections are made to the specification. No new matter is added. In the claims, claims 33, 88, 89, 91, 99, 101 and 125 are currently amended. Claim 126 is canceled. No new claims are added.

In a nutshell, the present claims describe systems and methods for immediately and automatically “grabbing” a desired domain name when it becomes available, thereby acquiring the registration for an interested party before any other party can do so. This is achieved through cooperation, in various embodiments, with one or more Registrars and or the relevant Registry. See paragraphs 0048-0054 in the Specification. As explained below, nothing disclosed in Schneider would have enabled the automatic acquisition of a domain name as claimed herein.

¹ Claims 13, 44-63 and 69-87 were withdrawn from consideration, without prejudice, in response to the June 22, 2005 Office action requiring restriction. Claims 1-12, 14-32, 34-43, and 64-68 were cancelled, without prejudice, in response to the June 22, 2005 Office action.

² At page 3, the Office action states that claims 33 and 88-126 are rejected under Section 102(e); however, the detailed discussion shows that the rejections of claims 92-94, 104-106 and 111-116 were actually based on Section 103(a) –see Office action at pages 8-11.

II. SCHNEIDER DOES NOT ANTICIPATE ANY OF CLAIMS 33, 88-91, 95-103, 107-110 and 117-126

A. The Prior Art.

Schneider discloses integrating together traditional domain name (“DN”) resolution services, registration services and search services – all methods to help users find and register available domain names. See column 1, lines 25-30 (Field of the Invention). Briefly, according to Schneider, a DN lookup using the WHOIS service is effected to determine the availability of a desired DN. As the Examiner points out, Schneider teaches:

“a method for processing a search request includes the steps of determining that the search request includes an identifier having a valid domain name, determining whether the valid domain name is available for registration, providing a registration form when the domain name is determined available for registration, and providing registrant information when the domain name is determined not available for registration.” Column 7, lines 40-45.

Thus, according to Schneider, there are two cases: (a) if the DN of interest is currently available for registration, Schneider teaches automatically providing a registration form so that the user can conveniently register the name. On the other hand, (b) if the DN is not available for registration, Schneider’s method provides the current registrant’s information (e.g. contact information) to the user.

Domain Names “Soon to be Available”

Schneider also suggests a determination of whether a domain name is “soon to be available” for registration. Schneider explains what this phrase means:

“FIG. 9b is a flowchart illustrating a methodology for notifying a client that a domain name is available or may soon be available for registration. A WHOIS record may be retrieved by initiating a WHOIS request or retrieved in response to processing a resolution request, search request, and registration request. Whatever the case, whenever a WHOIS record is retrieved (step 950), the expiration date for the domain name of the WHOIS record is parsed and compared in step 954 to the current date. When the difference between the expiration date and current date is determined in step 958 to be less than a predetermined threshold value (e.g., 30 days), a client may be notified in step 962 that the domain name may soon be available.” (Emphasis added.)

Thus, according to Schneider, a domain name is “soon to be available” if the corresponding registration expiration date is coming up, say in a couple of days or weeks.

Schneider also states the following:

[A list of] “Domain names that are soon to be available may be distributed in advance to a user so that domain names of interest may be selected and reserved in a preordering queue on either the client or server side. Registration information is completed and a registration form is submitted to or by a registrar when the soon to be available domain name that is selected does become available.” Column 24, lines 22-24.

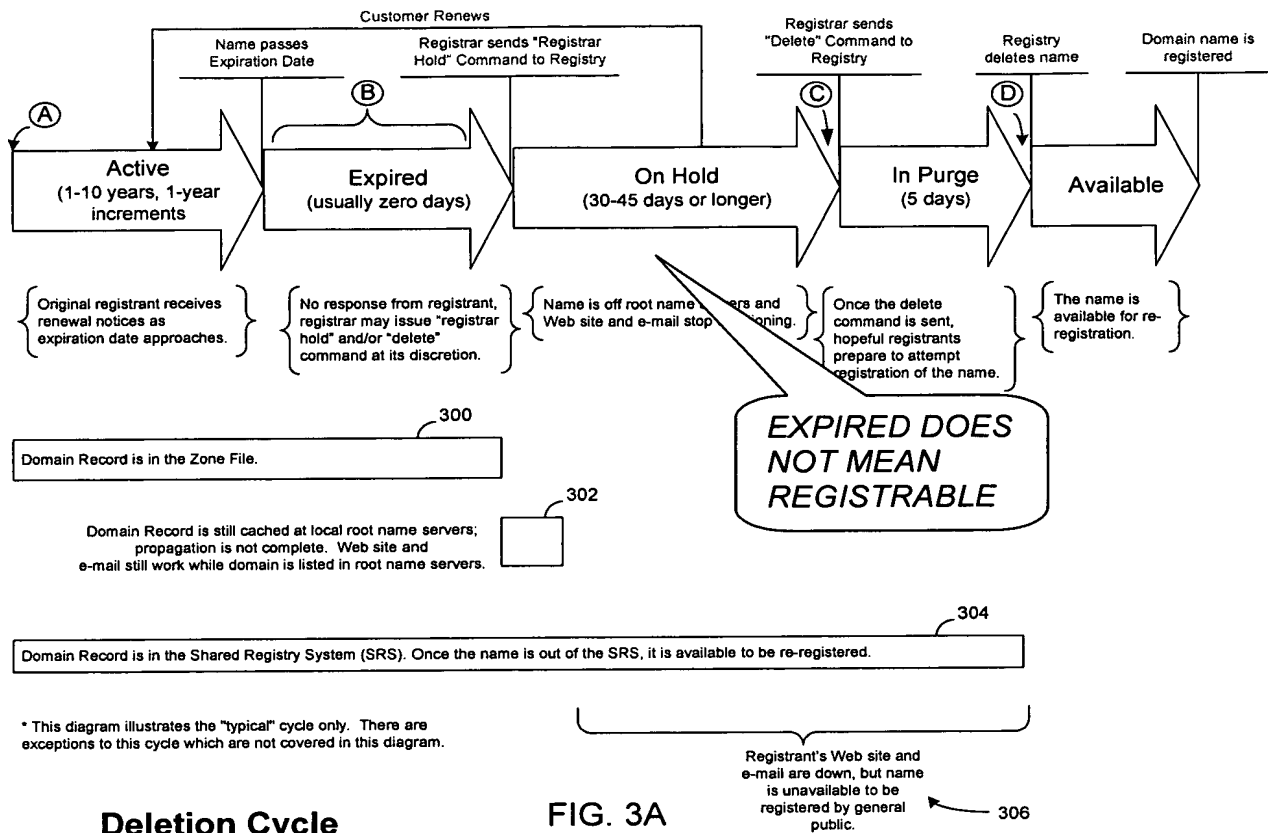
In other words, Schneider suggests some coordination among information lookup services (WHOIS) and registration services in one place. A user can select a DN in advance of it becoming available and, if and when the name actually becomes available, submit a completed registration form to a registrar. (Hardly a novel concept.) At that juncture, the user has no advantage over any other user who may try to register the name. The user simply has to act as quickly as possible once any notice is received and read.

B. Expiration of a Domain Name Registration does Not Make the Name Registrable.

An expired name is not necessarily currently available for registration. In fact, there is typically a delay of at least several weeks before a domain name that was previously registered but now expired actually becomes available for registration. See the “Deletion Cycle” below. Schneider, as shown above, conflates expiration (of a prior registration) with availability for registration to a new registrant.

Looking up the expiration date from the WHOIS record is not “predicting an earliest moment of registrability” because registrability comes later, and indeed may not occur at all. The deletion cycle timeline,³ applicant’s FIG. 3A, reproduced below. (The bubble callout is added.) It illustrates the time periods and activities that typically occur in the registration system after the DN expiration date, and before the name becomes publicly registrable, which is only after purge, often 30 to 50 days after expiration. See Specification paragraphs [0044]-[0047], “Domain Name Deletion and Registrability Timing.” Note in the figure, reference box 304: “Domain Record is in the Shared Registry System (SRS). Once the name is out of the SRS, it is available to be re-registered.” That box 304 extends temporally until the name is purged from the registry. Thus, any attempt by a user to register a name immediately after receiving notice from Schneider’s system that the corresponding registration has expired, will fail.

³ While the details of the Deletion Cycle have evolved since this case was filed in 2001, the process remains generally similar to that illustrated. The key distinction between expiration and availability for registration or re-allocation of a name has not changed.



C. Applicant's Claims 33.

"33. (Currently amended) A method for domain name management comprising: identifying a domain name with a first registration; identifying an interested party desiring a succeeding registration for the domain name; monitoring a status of the first registration; and immediately and automatically effecting the succeeding registration to the interested party when the status of the first registration indicates that the domain name is registrable, without further action by the interested party."

D. Claims 88-91.

Claim 88 is amended to read as follows:

88. (Currently amended) A method according to claim 33, further comprising determining an expected ~~expiration~~ deletion date for the first registration.

Claim 88 thus is dramatically different from the teaching of Schneider at least in that Applicant's claim calls for determining an expected deletion date for the first registration, which is quite different from looking up the expiration date as taught by Schneider. Indeed, the Examiner later observed that, "Schneider fails to teach explicitly further determining a deletion time period during which the first registration is expected to delete from the registry". See Office Action, page 10, last paragraph. That is correct; based on an automated word search, "deletion date" does not appear anywhere in the Schneider patent. The rejection of claim 88 should be withdrawn.

Claim 89 is amended for consistency to read as follows:

"89. (Currently amended) A method according to claim ~~33~~ 88, further comprising: defining a time period for monitoring the status based on the expected ~~expiration~~ deletion date; and periodically checking the status within the defined time period."

This claim plainly is not anticipated by Schneider for the reasons discussed above and should be allowed. Schneider at best suggests checking the status of a registration when the expiration date is drawing near. See Schneider at column 24, lines 34-46. Claim 89 thus is not anticipated.

Claim 90 (depending from claim 89) calls for: "checking the status at a predefined frequency during the time period". The Examiner cites to a passage in Schneider that reads as follows:

"When a domain name is received as input to a registration service, the availability of the domain name is determined. If the domain name is not available, registrant information is returned and the client is notified that the domain name in question is not available and may provide the option of checking the availability of other domain names. When a domain name is available, a user may be presented with the choice of registering the domain name. Upon completion of registration, another domain name may then be checked for availability."

That passage reveals no hint of checking the status at a predefined frequency as claimed here. As the Examiner doubtless is aware, "[a]nticipation under § 102 requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim." *Sandt Tech. v. Resco Metal and Plastics Corp.*, 264 F.3d 1344, 1350 (Fed. Cir. 2001) (quotations and citations omitted) (emphasis added). See also MPEP § 2131. Such is not the case here. For these reasons, claim 90 should be allowed.

Regarding claim 91, the claim is amended to read as follows:

“91. (Currently amended) A method according to claim 90, further comprising:
 predicting an earliest moment of registrability for the domain name based on the expected ~~expiration~~ deletion date; and
 increasing the frequency of said checking, proximate to the predicted earliest moment of registrability.”

The Examiner rejected this claim, relying solely on citation to Schneider, column 24, lines 34-37, with respect to the first step of “predicting an earliest moment of registrability.” Applicant respectfully dissents. Schneider says the following at the cited passage, no more and no less: “Whatever the case, whenever a WHOIS record is retrieved (step 950), the expiration date for the domain name of the WHOIS record is parsed and compared in step 954 to the current date.”

Schneider discloses nothing about a deletion date, as noted previously. Applicant’s specification explains, for example, “The present invention can then periodically and automatically check with one or more combined registries/registrars or a central registry and automatically register a name if the name is available, or re-register a registered name if the registration period has expired and the name is about to delete.” Paragraph [0036] (emphasis added). Further, according to Applicant’s specification, paragraph [0042]: “For example, the scope of acquisition services can encompass monitoring all changes in the registration record for a given domain name. ... If the registration expires and the domain deletes, the domain name can be acquired automatically and instantly on behalf of the subscriber.” (Emphasis added.) The name must delete before it becomes registrable, as illustrated in FIG. 3 above.

Because Schneider’s system does not, “predict[] an earliest moment of registrability for the domain name, it cannot possibly, “increas[e] the frequency of said checking, proximate to the predicted earliest moment of registrability.” For at least these reasons, Schneider does not anticipate any of claims 89-91.

Claims 92-94 were rejected under Section 103 and are discussed below.

Claim 95 calls for:

“ 95. A method according to claim 89, wherein said checking includes receiving a communication pushed from a registrar.” (Emphasis added.) The Examiner cites to Schneider, at column 4, lines 15-21, which reads exactly as follows:

“A WHOIS request is performed to determine domain name availability. When a domain name is already registered (e.g., determined not available), registrant information may be provided to the client system. However, when the domain name is available, a registration form may be processed and submitted to a registrar and/or registry and to its partners and/or affiliates.”

While a WHOIS request as disclosed by Schneider can be read on checking the status of a registration, that is not pushed from a registrar. It is well known that, “Push (or “server-push”) is the delivery of information on the Web that is initiated by the information server rather than by the information user or client, as it usually is.” (See http://whatis.techtarget.com/definition/0,,sid9_gci212846,00.html (Emphasis added.)). By contrast, a WHOIS response is just that --a response, not a push from a registrar. For at least these reasons, Schneider does not anticipate claim 95.

Similarly, claim 96 recites, “A method according to claim 89, wherein said checking includes receiving a communication pushed from a registry.” This is not disclosed in the passage applied by the Examiner; the claim should be allowed.

Claims 97-98 depend from claim 33 and are not argued as independently patentable.

E. Claims 99 and 100.

Claim 99 is amended to read as follows:

99. (As Currently amended) A method according to claim 33, wherein said effecting of the succeeding registration includes initiating multiple substantially contemporaneous requests to register the domain name. (Emphasis added.)

Claim 99 depends from Claim 33 but it is also independently patentable. The Examiner rejected claims 99 and 100 (Office Action, page 5) relying solely on citation to Schneider, figure 4a and column 16, lines 29-55. Applicant respectfully traverses the rejection. Schneider’s figure 4a, according to his own brief description, “is a flowchart illustrating the steps performed for processing a renewal request in response to detecting a ‘renew’ domain name prefix from an input request in accordance with the present invention.” Column 8, lines 56-59. Claim 99 is not about renewals. In the case of a renewal by the current registrant, the DN is never purged and never becomes publicly available for a “succeeding registration” – the subject matter of claim 99.⁴

⁴ Even after expiration, the sponsoring Registrar has the option, for a time, to renew rather than delete the registration. See Applicant’s FIG. 3, above (“registrar hold”).

The text cited by the Examiner is directed to processing a search/ renewal request, but in any case, individual requests, if appropriate, are simply “redirected in step **430** to a registrar for the purposes of processing in step **450** a renewal registration request,” or if the name is not registered, “the FDN is redirected in step **440** to a registrar for the purposes of processing in step **450** a renewal registration request.” This illustrates Schneider’s proposal for integrating search and registration services. The redirected request, however, is merely conventional; a registration request is redirected to a registrar to process according to Schneider.

Claim 99, by contrast, “includes initiating multiple substantially contemporaneous requests.” This concept is illustrated, in one embodiment, in Applicant’s FIG. 3B reproduced below, in which multiple communication paths are shown labeled “D” for reference. In FIG. 3B as shown below, a dashed box is added, labeled “SCHNEIDER” in the upper-right corner, indicating the functional features disclosed in the Schneider reference; i.e., a “front end” or user interface such as a web page (324); a “processing engine” such as a web site back end (320); and access to the public WHOIS facility 326.

Expiring Domain Name Acquisition Cluster

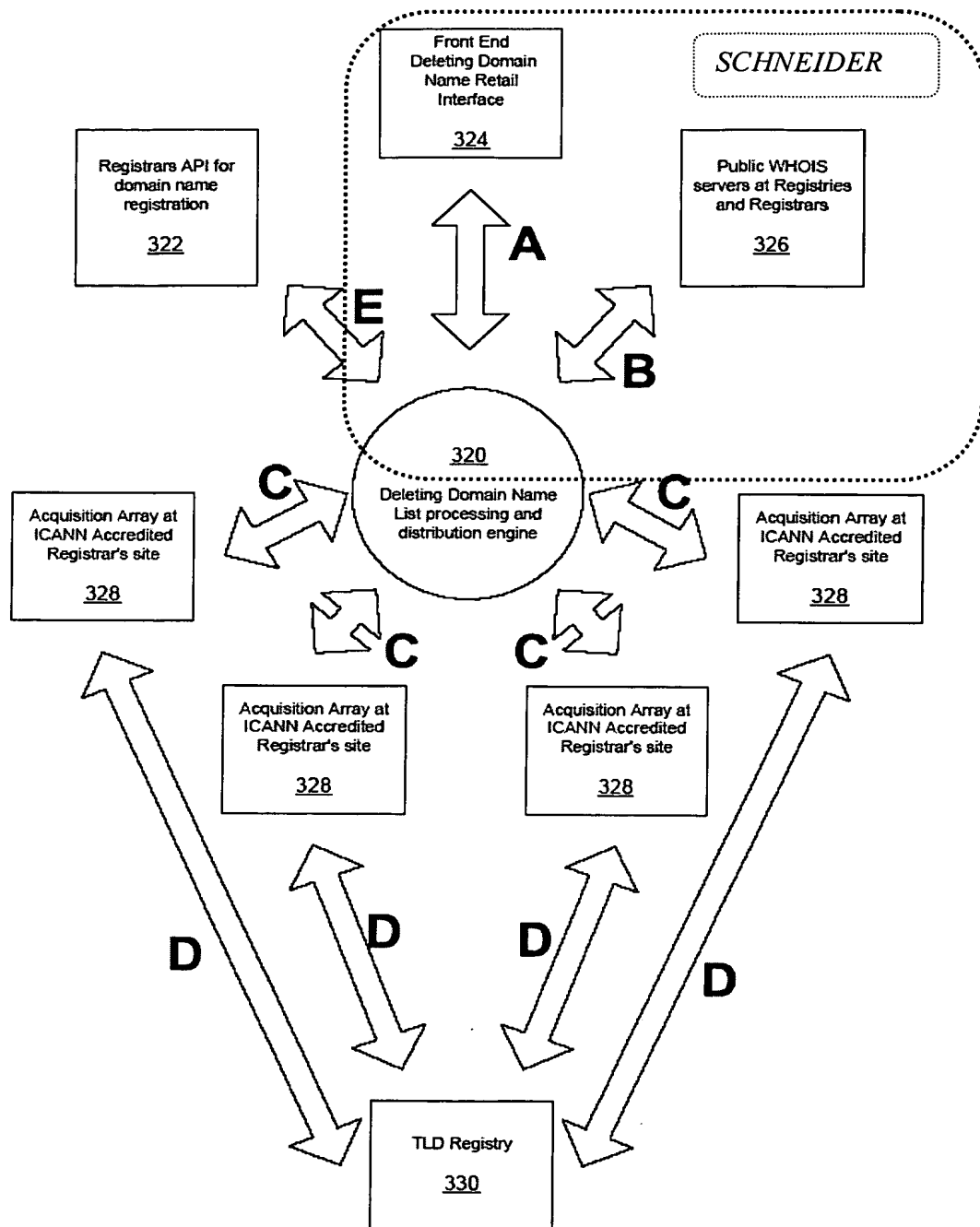


FIG. 3B

This limitation is not disclosed by Schneider. As explained in the Specification, this methodology substantially increases the likelihood of success in acquiring the name. See paragraphs 0053-0056. Accordingly, claim 99 and claim 100 should be allowed, in addition

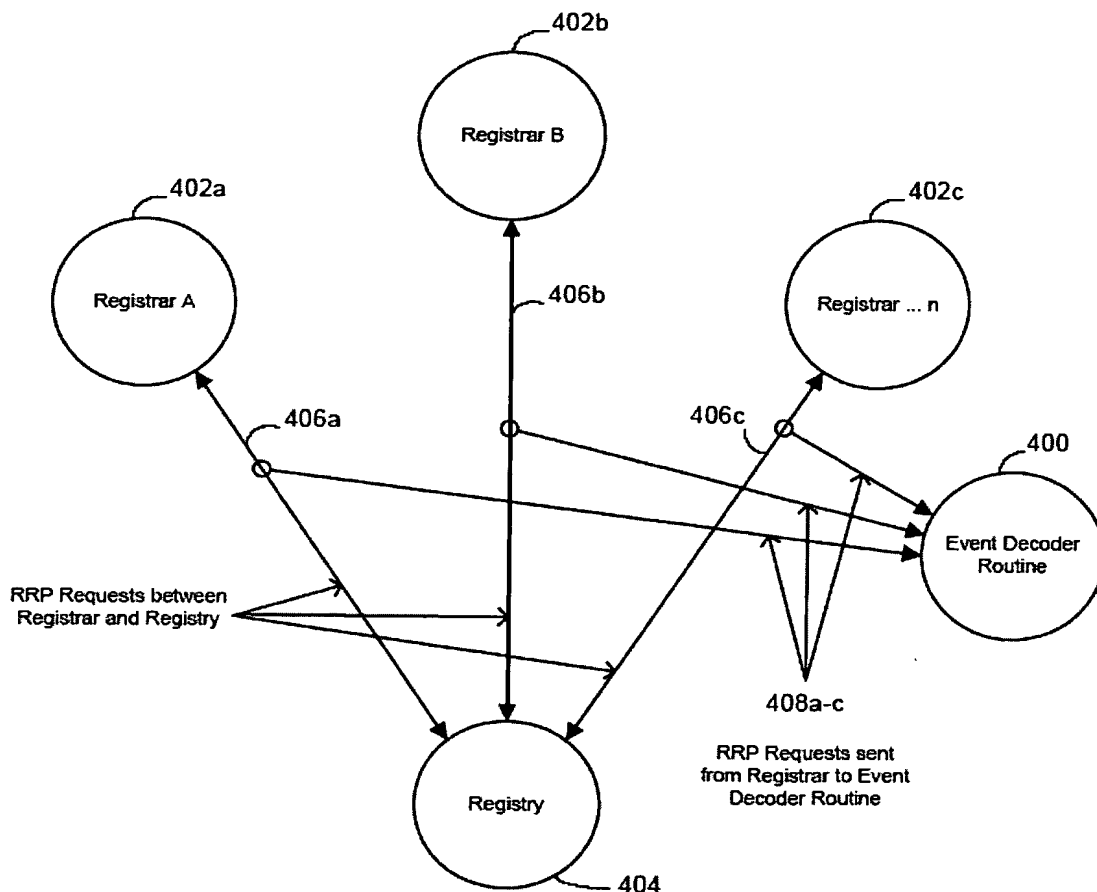
to the reasons explained above, as the cited reference does not disclose initiating multiple substantially contemporaneous requests to register a desired domain name.

F. Claims 101-103

The claim recites, “101. (Currently amended) A method according to claim 33, wherein the first registration is maintained by a registry, and further comprising:

monitoring a request between a registrar and the registry to detect an event affecting the first registration[[]];” (Emphasis added). In one embodiment, such monitoring a request between a registrar and a registry (RRP Requests) is illustrated in **Applicant’s FIG. 4** as follows:

Registrar Connection to Event Decoder Routine



The Examiner cited to Schneider; the cited passage reads as follows:

“The present invention enables more specific error messages to be generated in response to an input request. The invention enables search results to be integrated a part of the results from a registration request. The present invention enables the integration of metalinks (e.g., maps, after market domain name information, etc.) as part of results from a WHOIS request. The invention enables distributed WHOIS caching to minimize network connection bandwidth. The present invention enables the real-time display of registrant information that corresponds to a current URI. The invention enables automatic notification of any identifiers that may soon be available in response to accessing such an identifier.” Schneider, column 7, lines 17-28.

That passage says nothing about, “monitoring a request between a registrar and the registry to detect an event affecting the first registration” as required by the claim. The Examiner asserts the same ground for rejection as to claims 102-103. For at least these reasons, the rejection of claims 101-103 should be reconsidered and withdrawn.

Claims 107, 108, 109, 110 and 121 also were rejected as allegedly anticipated by Schneider. These claims depend from claim 33 which provides the context for proper consideration of patentability of the claim as a whole:

“33. (Currently amended) A method for domain name management comprising:
 identifying a domain name with a first registration;
 identifying an interested party desiring a succeeding registration for the domain name;
 monitoring a status of the first registration; and
immediately and automatically effecting the succeeding registration to the interested party when the status of the first registration indicates that the domain name is registrable,
without further action by the interested party.”

It should be borne in mind that the claim first identifies a DN that is registered. As noted above, Schneider teaches conducting a search of a domain name, and then either: (a) redirecting to a registration service if the name is not already registered; or (b) providing current registrant information (e.g., contact info) if the name is registered.⁵ Claim 33 begins with a name that is registered, identifies “an interested party desiring a succeeding registration for the domain name,” monitors its status, and then “automatically [effects] the succeeding registration when the status of the first registration indicates that the domain name is registrable”.

⁵ “A WHOIS request is performed to determine domain name availability. When a domain name is already registered (e.g., determined not available), registrant information may be provided to the client system. However, when the domain name is available, a registration form may be processed and submitted to a registrar and/or registry and to its partners and/or affiliates”. Column 14, lines 15-19.

Schneider discloses publishing a list of names that are “soon to be available” based on their expiration dates, but there is no disclosure in Schneider of “*automatically effecting* the succeeding registration to the interested party” per claim 33, and further there is no disclosure of, “identifying a second interested party; and auctioning the succeeding registration between the interested party and the second interested party,” per claim 107. Even if a second user indicated interest in a name in response to the publication of a list of names that are “soon to be available,” Schneider does not teach auctioning the name as between those two parties. Rather, the passage cited by the Examiner refers to Schneider’s proposal to return search results in response to a query or search for a particular name. Schneider says:

“FIG. 3*b* illustrates how search results may be enhanced by providing links to URIs of meta-information generated from domain names in accordance with the present invention...”. “Domain name status may indicate whether the domain name is available for sale, license, or lease by the registrant or through an auction and/or listing service”. Column 14, lines 37-52. Thus while Schneider implies that auctioning a domain name in general is known, it does not enable the steps of Applicant’s claims 107 et seq. Claims 108, 109, 110, 121 are not argued as independently patentable. Claim 117 is not argued as independently patentable apart from the base claim.

Claims 118-121. Claim 118 recites: “A method according to claim 33, wherein the first registration is maintained by a registry and sponsored by a registrar, and further comprising:

prior to a purge of the first registration from the registry, re-allocating the domain name to a selected entity, whereby the domain name is not deleted by the registry”.

The subject matter of this claim not only is not anticipated by Schneider, it is squarely contrary to the teachings of Schneider. Schneider discloses directing a user to a registrar or a registration service to register a desired name when, and only when, a search result shows that the name is NOT currently registered. Schneider also talks about making a list of names soon to be available, but it is clear throughout Schneider’s patent that AVAILABLE means publicly available for registration by anyone; this occurs only AFTER the name (the preexisting registration) has been purged from the Registry. Schneider nowhere suggests a re-allocation of the name prior to purge.

The Examiner cited two passages from Schneider. The first passage was discussed above and does not support the rejection. The second reads, regarding a web site interface:

“ ‘Watch **example.com**’ may enable a user to add "example.com" to a watch list for notifying the user as to similar domain names registered or to notify that ‘example.com’ is available or may soon be available for registration. ‘Renew example.com’ enables a registrant to extend the expiry date of ‘example.com’ and provide the option of transferring from one registrar to another. ‘Transfer example.com RegistrarA to RegistrarB’ may enable a registrant to transfer ‘example.com’ from a current registrar A to a new registrar B.”

Schneider thus describes possible actions by a user –namely, the current Registrant of a name, for example, to watch the status of a name. The “Transfer” action here is described as enabling the registrant to transfer his domain name, “from a current registrar A to a new registrar B.” That action changes the sponsoring Registrar—it does NOT re-allocate the name to a different Registrant (in the Registry) as recited in Applicant’s claim. Indeed, a user/ Registrant has no ability to directly re-allocate a name to a new registrant prior to purge; it must be done by the sponsoring Registrar. (After purge, the former Registrant cannot do anything relative to the name, other than request a new registration through a qualified Registrar, just like everyone else.) For at least these reasons, the rejection of claims 118-121 should be reconsidered and withdrawn.

Claim 122: “A method according to claim 121 wherein said auctioning is conducted prior to the first registration entering a ‘pending delete’ status”. (Emphasis added.) Schneider mentions auction of a registered domain name at the request of the current registrant. Schneider does not disclose auction of an expired domain name between the expiration date and the first registration entering a ‘pending delete’ status. In prior art, it was known to auction a live, currently registered name. One important aspect of the invention of claim 122 is conducting an auction of an expired domain name registration before it enters the pending delete status, at which time the sponsoring Registrar no longer has control of the name. For at least these reasons, the rejection of claim 122 should be reconsidered and withdrawn.

Claim 123 is not argued as independently patentable apart from claim 33.

Claim 124 was rejected on the same grounds as claim 33 (Office action, page 3). Applicant respectfully traverses for the same reasons as set forth above with regard to claim 33.

Claim 125, as Currently amended, recites: “A system according to claim 124, wherein:
the domain name is sponsored by a registrar having access to a registry that maintains the first registration;

said means for identifying the domain name includes an input means for receiving an indication of the domain name; and

said means for monitoring the status of the first registration includes an acquisition ~~engine~~ array coupled to the input means and integrated with the registrar so as to enable the acquisition ~~engine~~ array to determine the status of the first registration and to immediately effect registration of the domain name when the status indicates that the domain name is registrable".

An "acquisition array" in one embodiment is described in the Specification as follows:

"[0048] As can be seen with reference to Figure 3A, punctual timing is crucial when trying to register a recently available domain name. Embodiments of the present invention achieve a high success rate in domain name acquisition either by implementing a "deleting domain name acquisition cluster," which is a distributed system designed to monitor and register domain names as soon as possible after they are deleted from a registry, or by integrating an acquisition engine directly into the registry system. The components of an acquisition array system include a front end that receives requests from customers wanting to register soon to be deleting domain names, a processing and distribution engine, and one or more acquisitions arrays that operate in connection with a registrar's site for direct communications with a registry to perform the necessary operations to monitor and add domain names. The manner in which these various components communicate with each other is schematically diagrammed in Figure 3B." (Emphasis added.)

See also paragraphs 0049 et seq. Schneider does not disclose or suggest an "integrated with the registrar" process of using one or more cooperating Registrar's communication links directly into the registry to enable acquiring the domain name. For at least these reasons, the rejection of claim 125 should be reconsidered and withdrawn. Claim 126 is canceled.

III. CLAIM REJECTIONS BASED ON ALLEGED OBVIOUSNESS

A. Claims 92, 93, 94 are not argued as independently patentable. They all depend from claim 89 which in turn depends from claim 88 which in turn depends from claim 33, each of which is patentable at least for the reasons explained above regarding alleged anticipation.

B. Claims 104, 105, 106 and 111-116 were rejected as unpatentable over Schneider in view of Hollenbeck et al. Claims 104-106 are not argued as independently patentable. Claim 111 is patentable for at least the following reasons. It recites:

“111. (Previously presented) A method according to claim 33, wherein the first registration is maintained by a registry, and further comprising:

determining a deletion time period during which the first registration is expected to delete from the registry; and

during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name to succeed the first registration.”

The Examiner observed that “Schneider fails to teach explicitly further determining a deletion time period during which the first registration is expected to delete from the registry”. See Office Action, page 10, last paragraph. The Examiner asserts that Hollenbeck teaches that limitation, and further teaches, during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name to succeed the first registration. Office Action, page 11. And finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Hollenbeck to arrive at the claimed invention. One would have been motivated to do so, the Examiner states, “to allow updates to domain names registered by the registrar (page 3, [0036]; page 5, [0051])”. Applicant emphatically traverses this ground of rejection at least because, even assuming *arguendo* that the proposed combination were proper, Hollenbeck (a) does NOT teach determining a deletion time period; and (b) does NOT teach the last claim limitation. Consequently, the combination does not render the claim as a whole unpatentable.

Hollenbeck discloses at [0036]:

“The apparatus and method of the present invention processes domain name registration operations in a shared registration system comprising a plurality of registrars providing internet domain name registration services within the TLDs administered by a registry. Registrars access the registry through a

registry-registrar protocol (RRP) to register domain names and perform domain name-related functions such as the registration of name servers, renewal of registrations, deletions, transfers, and updates to domain names registered by that registrar. Registrars have a web-based interface to access the registry to perform administrative functions, generate reports, perform global domain name updates, and perform other self-service maintenance functions not available via RRP. The RRP is implemented by the registry to provide adequate security and authentication functions to protect the registry database while supporting all necessary registrar operations.”

Hollenbeck thus describes the basic SRS shared registration system and, more specifically, a web-based interface for authorized Registrars to access the Registry to perform various functions. At best, in accordance with Hollenbeck, a registrar might access the registry and find that a registration was past expiration and pending deletion. To grab the name, i.e., “during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name to succeed the first registration,” (claim 111) is taught by Applicant, not by Hollenbeck. Hollenbeck merely shows that a registrar *could* renew or transfer a name, if it was not too late. Hollenbeck [0051] further described the SRS system. This falls far short of the invention presently claimed. For at least these reasons, the rejection of claim 111-113 should be reconsidered and withdrawn.

Claim 115 recites: “A method according to claim 33, wherein the first registration is maintained by a registry, and further comprising:

obtaining a list of deleting domain names maintained by the registry associated with an upcoming deletion date; and

if the first registration is on the list, prior to actual deletion of the first registration, requesting a new registration of the domain name to succeed the first registration.”

The Examiner did not explain the grounds for rejection of this claim; it was grouped together with claims 33, 111 etc. This claim requires “obtaining a list of deleting domain names maintained by the registry associated with an upcoming deletion date”. Schneider teaches obtaining a list of expired domain names, which is not the same as deleting names. Expired names are often renewed before moving to deletion, which is of course why Schneider states that they MAY soon be available for registration (or may not). Schneider does not disclose a list of deleting names from the registry, and certainly does not disclose a list “associated with an upcoming deletion date”. The last limitation of the claim requires such a list. Hollenbeck does not disclose it either. For at least these reasons, the rejection of

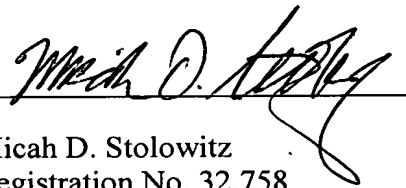
claim 115 should be reconsidered and withdrawn, or the Examiner should fairly make out a *prima facie* case of obviousness to which the Applicant can respond.

IV. CITATION OF RELEVANT PRIOR ART

Finally, the Examiner states that, "2002/0103820 could be used for 102 rejection". That obviously is not a rejection to which Applicant can respond, and so it does not. Similarly, the Examiner states, "Prior art 6,880,007; 2002/0129013 and 2002/0010795 could be used for 103 rejection." This statement does not make out a *prima facie* rejection, and once again, this is not a rejection to which Applicant can respond, and so it does not.

Snapnames.com, Inc.

By



Micah D. Stolowitz
Registration No. 32,758

STOEL RIVES LLP
900 SW Fifth Avenue, Suite 2600
Portland, OR 97204-1268
Telephone: (503) 224-3380
Facsimile: (503) 220-2480
Attorney Docket No. 10720/2:4